

## **REMARKS**

Applicants propose amending claims 1 and 10, and canceling claims 19-25, which the Examiner withdrew subsequent to a restriction requirement, without prejudice or disclaimer of the subject matter thereof. Upon entry of this amendment, claims 1-18 will be pending in this application.

In the Final Office Action, the Examiner took the following actions:

objected to the specification for failing to provide proper antecedent basis for the claimed subject matter of claim 10 under 37 C.F.R. 1.75(d)(1); and

rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over *Coiera et al* (U.S. Patent Application Publication No. 2005/0086204) in view of *Fontana et al* (U.S. Patent No. 6,167,564).

### **I. OBJECTION TO THE SPECIFICATION**

The Examiner objected to the specification for failing to provide proper antecedent basis for the claimed subject matter of claim 10. Specifically, the Examiner alleges that the recited "medium" lacks support or antecedent basis under 37 C.F.R. 1.75(d)(1). To expedite prosecution, Applicants have amended the specification to expressly recite "an article comprising a machine-readable medium," as suggested by the Examiner. Applicants respectfully submit that the amended specification provides proper support and antecedent basis for the claimed subject matter of claim 10 under 37 C.F.R. 1.75(d)(1). The objection to specification should therefore be withdrawn.

## **II. REJECTION OF CLAIMS 1-18 UNDER 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over *Coiera* in view of *Fontana*. No prima facie case of obviousness has been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the

prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Amended claim 1 recites a method including, inter alia, “completing workflow of a process modeling tool by using the matching resource, wherein the process modeling tool enables creation of new business workflow and collaborative workflow within an enterprise management system” (emphasis added).

In rejecting claim 1, the Office Action alleges that *Coiera* teaches “completing workflow of a process modeling tool by using the matching resource.” (Office Action, pg. 4). The Office Action asserts that “*Coiera* discloses that the main purpose of creating the template is to receive resources that will allow for medical professionals to make clinical decisions, which reasonably provides insight to one skilled in the art that completion of a workflow process is contingent on the matching resource.” *Id.* The Office Action’s allegation is incorrect at least for the following reasons.

*Coiera* discloses “search systems which are available to search data sources over networks such as the Internet.” (Paragraph [0002]). *Coiera* further discloses “search systems arranged to search data sources such as databases which are provided for specialist searching, such as medical databases, which may or may not be available over networks such as the Internet.” *Id.* As noted by the Examiner, medical professionals may use the data returned by *Coiera*’s search systems “to make clinical decisions.” *Id.*; see also Office Action, pg. 4. In addition, as asserted by the Examiner, *Coiera* provides “the use of the matching resources in this situation provides for completion of someone making a decision” (emphasis added). *Id.* *Coiera*, however, does not teach or suggest “completing workflow” using a “process modeling tool,” which

“enables creation of new business workflow and collaborative workflow within an enterprise management system,” as recited in claim 1. Therefore, *Coiera* does not disclose or suggest “completing workflow of a process modeling tool by using the matching resource, wherein the process modeling tool enables creation of new business workflow and collaborative workflow within an enterprise management system,” as recited in claim 1, at least for the above reasons.

*Fontana* does not compensate for the deficiencies of *Coiera*. The Office Action alleges that “*Fontana* teaches an enterprise management system that comprises cross-functional applications to manage at least one resource.” (Office Action, pg. 4). In addition, the Office Action alleges that “*Fontana* teaches linking domains, business models and components as part of the application’s development.” *Id.* Even if these allegations are correct, which Applicant does not concede, *Fontana* does not teach or suggest “completing workflow of a process modeling tool by using the matching resource, wherein the process modeling tool enables creation of new business workflow and collaborative workflow within an enterprise management system,” as recited in claim 1.

In summary, the Office Action has neither properly determined the scope and content of *Coiera* and *Fontana*, nor properly ascertained the differences between these references and claim 1. Furthermore, the Office Action has not clearly articulated a reason why independent claim 1 would have been obvious to one of ordinary skill in view of *Coiera* and *Fontana*. Therefore, a prima facie case of obviousness has not been established and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a), for at least the above reasons.

Independent claim 10, while differing in scope than claim 1, recites elements similar to those of claim 1 that were discussed above. Therefore, the Examiner should also withdraw the rejection of claims 10 under 35 U.S.C. § 103(a).

Claims 2-9 and 11-18 depend either directly or indirectly from independent claims 1 and 10. Accordingly, the rejection of claims 2-9 and 11-18 should be withdrawn at least due to this dependence.

### **CONCLUSION**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicants submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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